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No. 654

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U.S. SUPREME COURT
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Supreme Court of the United States

(October Term, 1947)

NATIONAL NUGRAPE COMPANY,
Petitioner,

VERSUS

JAMES D. GUEST, Trading and Doing Business Variously as
Tot Beverage Company and TruGrape Company,
Respondent.

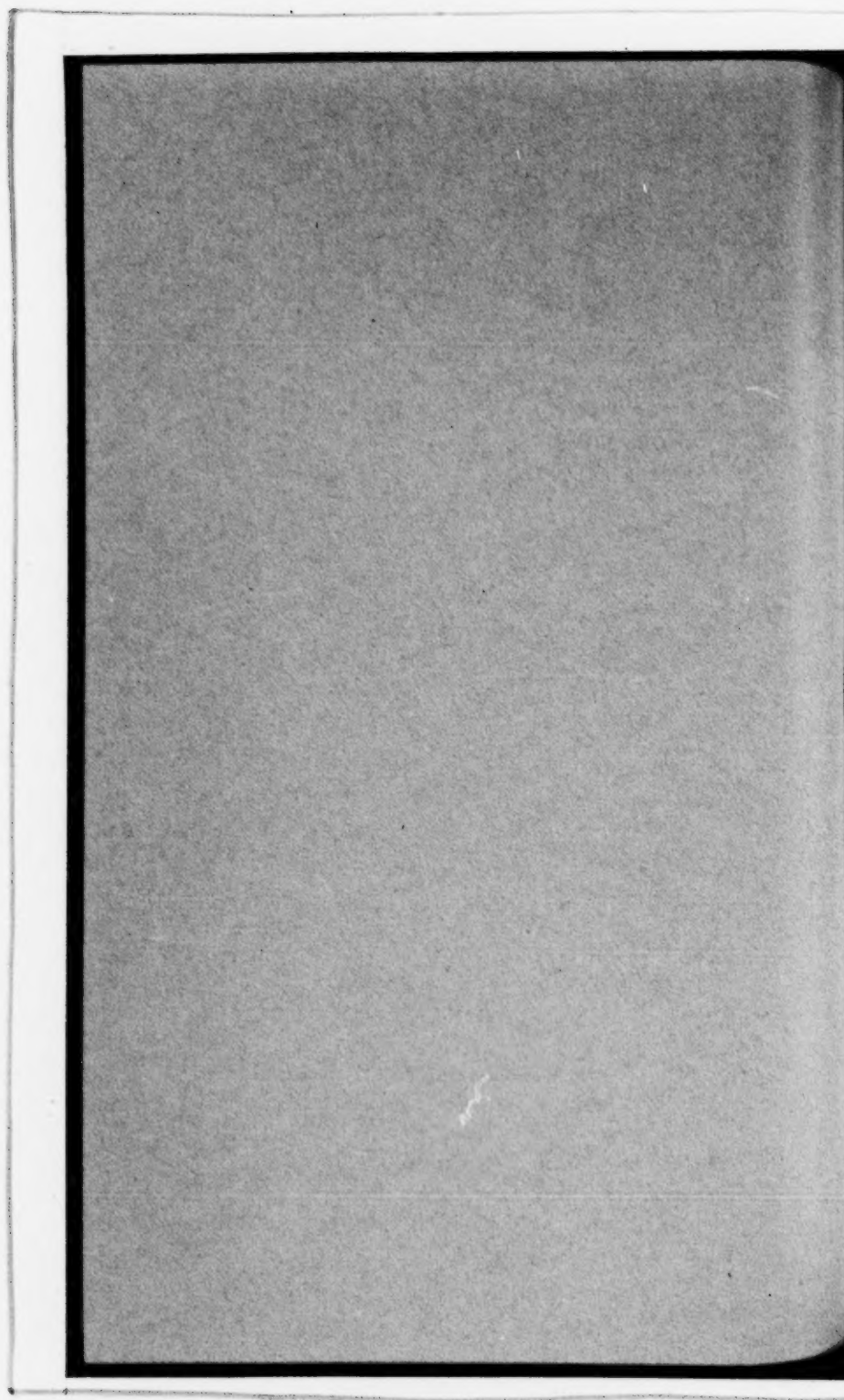
BRIEF OF RESPONDENT IN OPPOSITION TO **PETITION FOR WRIT OF CERTIORARI**

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March, 1948.



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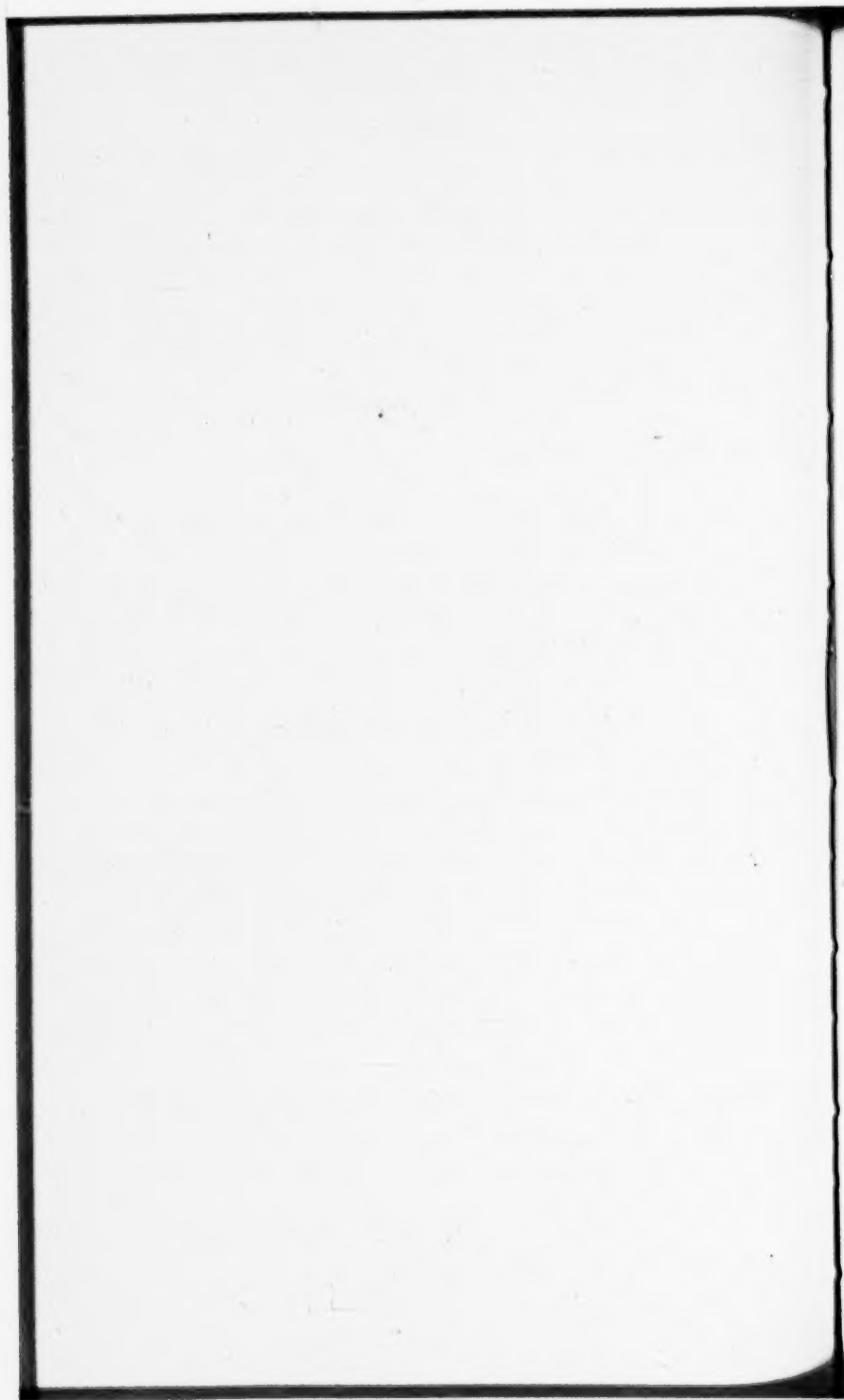
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Supreme Court of the United States
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NATIONAL NUGRAPE COMPANY,
Petitioner,

V E R S U S

JAMES D. GUEST, Trading and Doing Business Variously as
Tot Beverage Company and TruGrape Company,
Respondent.

**BRIEF OF RESPONDENT IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

OPINIONS BELOW

The opinion of the Circuit Court of Appeals appears on pages 83 to 87 of the Record and is reported in 164 Fed. (2d) 874. The Findings of Fact and Conclusions of Law of the District Court appear on pages 13 to 20 of the Record and are reported in 69 Fed. Supp. 863.

I.

STATEMENT OF THE CASE

This suit was brought in the District Court of the United States for the Eastern District of Oklahoma by petitioner against respondent for alleged infringement of petitioner's registered trade-mark and for unfair competition.

The judgment of the District Court which was in favor of respondent was affirmed by the United States Circuit Court of Appeals for the Tenth Circuit.

In affirming the judgment of the District Court, the Circuit Court of Appeals held that petitioner's alleged trade-mark "NuGrape" is a term made up of the words "new," misspelled, and "grape" and although registered under the Federal Trade-mark Act of February 20, 1905 (15 U. S. C. 81 *et seq.*) the term is not a valid trade-mark for the reason it is descriptive of petitioner's grape product; that petitioner's evidence fails to show infringement by unfair trade practices on the part of respondent, and further held:

"The most that can be said is that there is some similarity in sound between the words 'NuGrape' and 'TruGrape.' The evidence fails to show any confusing similarity in appearance, verbal translation of the pictures or designs used on the bottles, or any similarity in the appearance or construction of the bottles themselves. The evidence completely fails to meet the test that the ordinary prospective purchaser exercising due care under the circumstances would be misled" (164 Fed. [2d] 874, 877).

Neither the District Court nor the Circuit Court of Appeals held that petitioner's term "NuGrape" had acquired a secondary meaning.

THE EVIDENCE

Petitioner introduced in evidence the Certificate of Registration of the term "NuGrape" under the Trade-mark Act of February 20, 1905 (R. 30, 31, 77); Certificate of Re-

newal (R. 30, 31, 79), and Certificate showing registration in 1939 of the term "NuGrape" in the State of Oklahoma (R. 80). Petitioner called one of its officers and two of its investigators as witnesses. The officer testified that petitioner is a Georgia Corporation, located in Atlanta, Georgia; that petitioner and its predecessor have been manufacturing and marketing a carbonated grape drink since 1921 under the registered mark NuGrape. That petitioner, exclusive of its predecessor, has expended more than \$800,000.00 in advertising its beverages and sells its product in a majority of the states of the United States, including the State of Oklahoma, and that petitioner's sales have aggregated more than \$5,000,000.00. That the mark "NuGrape" was registered in 1923, in the United States Patent Office under the Federal Trade-mark Act of February 20, 1905, and on August 29, 1939, the term was registered with the Secretary of State of Oklahoma. This witness further testified that petitioner protested the use of the name "TruGrape" by respondent as being an infringement of its mark (R. 29-34). The two investigators testified to making calls, in the guise of customers upon the dealers in various towns in respondent's trade territory and of ordering either NuGrape or TruGrape, and that in about one-fourth of the places at which they called they were served one drink though they had asked for the other (R. 34-36).

Respondent testified (R. 47-54) that he had been connected with the soft drink industry since 1940 (R. 47); that his bottling plant completely equipped for bottling soft drinks is located at Duncan, Oklahoma (R. 51); that in the latter part of 1941 he began working on a formula for the

grape beverage which he sells under the term "TruGrape," and he began marketing the beverage in 1942 (R. 48); that the product of his formula "was a very true character of grape and that gave" him "the suggestion. That is why we selected 'TruGrape' because it described what we had * * * " (R. 52-53); that in the latter part of 1942 or the first part of 1943 he changed the name of his business to "TruGrape Company" (R. 53); that his business name and address, The TruGrape Company, Duncan, Oklahoma, appears on each of his bottles (R. 50). A bottle of petitioner's imitation grape beverage bearing the term "NuGrape" was introduced in evidence (Deft's. Ex. 1, R. 50) and also a bottle of respondent's imitation grape beverage bearing the term "TruGrape" was introduced in evidence (Deft's. Ex. 2, R. 50). Respondent testified to the shape and size of these bottles, the markings and crowns thereon, the lack of similarity (R. 50) and to the difference in color and flavor of the beverages (R. 51). These exhibits were transmitted on appeal to the Circuit Court of Appeals (R. 81).

Respondent's plant manager and sales supervisor was called and testified to respondent's sales methods and trade practices (R. 54-57).

Eight consumer witnesses and five dealer witnesses were called on behalf of respondent (R. 57-68). Each of the consumer witnesses testified in substance that he was familiar with the imitation grape beverage sold under the name "NuGrape" and with the imitation grape beverage sold under the name "TruGrape"; that he had purchased both of the beverages, occasionally helping himself, making his se-

lection from coolers in which both beverages were kept and had never experienced any difficulty in selecting the beverage desired; that he had never been given one of the beverages when he had requested the other and had never been confused between them and would not be confused (R. 57-68). Each of the consumer and dealer witnesses testified in substance that he did not know the source, origin or manufacturer of the beverage sold under the name "NuGrape." These witnesses testified that the term "NuGrape" signified to them "a grape flavor * * * It indicates to me what is in the bottle, the beverage. * * * it does not indicate to me in any way the source, origin or manufacturer of the product" (R. 57); " * * * simply grape soda" (R. 59); "A new drink * * * if I want a grape beverage that indicates a grape beverage to me" (R. 60); " * * * a grape soda" (R. 61); " * * * just a grape soda * * * I do not buy that beverage because I know where it is made or its origin * * * I buy it because I want a grape beverage, and the name indicates that is what is in the bottle" (R. 62); "I just thought * * * they had a new flavor * * * " (R. 63); " * * * soda pop to me. I do not buy either of those because I know where they are manufactured, or the origin. That name does not signify the maker of the beverage to me" (R. 63); " * * * merely * * * contents of the bottle * * * " (R. 64); " * * * does not suggest to me the origin or what company manufactures it. It simply signifies the contents" (R. 66).

II.

ARGUMENT

SUMMARY OF THE ARGUMENT

Point A. The decision of the Circuit Court of Appeals in holding the mark "NuGrape" invalid as a technical trade-mark does not ignore and is not in conflict with the Federal Statute involved.

Point B. The decision of the Circuit Court of Appeals in holding the mark "NuGrape" invalid is not in conflict with the decision of the Supreme Court in *Armstrong Paint & Varnish Works v. NuEnamel Corp.*, 305 U. S. 315.

Point C. The Circuit Court of Appeals in holding the mark "NuGrape" invalid as a statutory trade-mark and in not holding the term had acquired a secondary meaning did not ignore the evidence.

Point D. The holding of the Circuit Court of Appeals that petitioner's evidence fails to show an infringement on the part of respondent by unfair trade practices is not in conflict with a late decision of the Supreme Court and decisions of other Circuit Courts.

Point A.

The Decision of the Circuit Court of Appeals in holding the mark "NuGrape" invalid as a technical trade-mark does not ignore and is not in conflict with the Federal Statute involved.

Validity of petitioner's alleged trade-mark was made an issue by respondent's answer (R. 10).

The term "NuGrape" was registered by petitioner under the Trade-mark Act of February 20, 1905, (15 U. S. C. 81, *et seq.*). Section 5(b) of that Act provides:

"Provided, That no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods * * * shall be registered under the terms of this subdivision of this chapter * * * ."

Petitioner's product in connection with which it uses the term "NuGrape" is an imitation grape beverage, grape soda (R. 50, 57-68), a carbonated grape drink (R. 83; 164 Fed. [2d] 874, 875). A sample of the product was in evidence and before both the District Court and the Circuit Court of Appeals (R. 50, 81). Respondent's witnesses testified that the term "NuGrape" indicated to them "a grape flavor * * * . It indicates to me what is in the bottle, the beverage. * * * it does not indicate to me in any way the source, origin or manufacturer of the product" (R. 57); " * * * simply grape soda" (R. 59); "A new drink * * * if I want a grape beverage that indicates a grape beverage to me" (R. 60); " * * * a grape soda" (R. 61); " * * * just a grape soda * * * I do not buy that beverage because I know where it is made or its origin * * * I buy it because I want a grape beverage, and the name indicates that is what is in the bottle" (R. 62); "I just thought * * * they had a new flavor * * * " (R. 63); " * * * soda pop to me. I do not buy either of those because I know where they are manufactured, or the origin. That name does not signify the maker of the beverage to me" (R. 63); " * * * merely * * * contents of the bottle * * * " (R. 64); " * * * does not suggest to me the origin or what company manufactures it. It simply signifies the contents" (R. 66).

The evidence shows that the term "NuGrape" is merely descriptive of the product with which it is used, and not indicative of the origin or ownership of the product (R. 57-68; Ccn. of Law VII, R. 20; 164 Fed. [2d] 874, 876). The term is made up of the words "new," misspelled, and "grape." The cases dealing with such words and with words alleged to be an infringement on their use are numerous.¹

A term which is descriptive is not a good trade-mark at common law.²

A registered trade-mark is not valid when the term used is merely descriptive of the product, or its ingredients, qualities, or characteristics.³

The Circuit Court' holding (R. 85; 164 Fed. [2d] 874, 877)

"The trial court's finding that the term 'NuGrape' is descriptive of the plaintiff's grape product, and therefore, is not a valid trade-mark, is well founded,"

¹ For some of these cases, see *Armstrong Paint & Varnish Works v. NuEnamel Corp. et al.*, 305 U. S. 315; *Standard Paints Co. v. Trinidad Asphalt Mfg. Co.*, 220 U. S. 446; *Barton et al. v. Rex-Oil Co., Inc.* (3 Cir.), 2 Fed. (2d) 402; *Griffin Mfg. Co. v. It Shoe Polish Co.* (4 Cir.), 80 Fed. (2d) 514; *Steen-Electric Corp. v. Herzfeld Phillipson Co.* (7 Cir.), 118 Fed. (2d) 122; *Warner & Co. v. Lilly & Co.*, 265 U. S. 526; *Wagner's Sons Co. v. Orange Snap Co.* (5 Cir.), 18 Fed. (2d) 554; *Bliss, Fabyan & Co. v. Aileen Mills* (4 Cir.), 25 Fed. (2d) 370; *Wyatt et al. v. Mammoth Cave Development Co.* (6 Cir.), 26 Fed. (2d) 322; *Chicago Pneumatic Tool Co. v. Black & Decker Mfg. Co.*, 39 Fed. (2d) 684; *Van Camp Sea Food Co. v. Coburn-Hopkins* (9 Cir.), 56 Fed. (2d) 797; *Skinner Mfg. Co. v. Kellogg Sales Co.* (8 Cir.), 143 Fed. (2d) 895; *Ungles-Hoggette Mfg. Co. v. Farmers' Hog & Cattle Powder Co.* (8 Cir.), 232 Fed. 116; *C. B. Fleet Co. v. Mobile Drug Co.* (5 Cir.), 284 Fed. 813.

² *Armstrong Paint & Varnish Works v. NuEnamel Corp.*, 305 U. S. 315, 335; *Warner & Co. v. Lilly & Co.*, 265 U. S. 526, 528; *Standard Paints Co. v. Trinidad Asphalt Mfg. Co.*, 220 U. S. 446, 453; *Elgin Nat. Watch Co. v. Illinois Watch Co.*, 179 U. S. 665, 673.

³ *Warner & Co. v. Lilly & Co.*, 265 U. S. 526; *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U. S. 446; *Kellogg Co. v. National Biscuit Co.*, 305 U. S. 111; *Van Camp Sea Food Co. v. A. B. Stewart Organizations*, 50 Fed. (2d) 976.

is sustained by the evidence and the authorities and is not in conflict with any provision of the Federal Trade-mark Act of 1905.

Point B.

The Decision of the Circuit Court of Appeals in holding the mark "NuGrape" invalid as a statutory trade-mark is not in conflict with the Decision of the Supreme Court in *Armstrong Paint & Varnish Works v. NuEnamel Corp. et al.*, 305 U. S. 315.

As stated under Point A respondent's evidence (R. 57-68) shows that the term "NuGrape" is merely descriptive of the product with which it is used, and not indicative of the origin or the ownership of the product.

The Circuit Court of Appeals, citing some of the many cases holding such a mark invalid,⁴ and relying on their authoritativeness said (164 Fed. [2d] 874, 876):

"It has long been recognized that a registered trade-mark is not valid when the term used is merely descriptive of the product, or of its ingredients, qualities or characteristics."

And at page 877 held:

"The trial court's finding that the term 'NuGrape' is descriptive of the plaintiff's grape product, and therefore, is not a valid trade-mark, is well founded."

⁴ *Warner & Co. v. Lilly & Co.*, 265 U. S. 526; *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U. S. 446; *Kellogg Co. v. National Biscuit Co.*, 305 U. S. 111; *Van Camp Sea Food Co. v. A. B. Stewart Organizations*, 50 Fed. (2d) 976.

Nothing appearing in the *NuEnamel* case required the Circuit Court of Appeals in the instant case, where the evidence shows the mark in controversy to be merely descriptive of the product with which it is used, to presume the mark valid and properly registered under the Trade-mark Act of 1905.

Point C.

The Circuit Court of Appeals in holding the mark "Nu-Grape" invalid as a statutory trade-mark and in not holding the term had acquired a secondary meaning did not ignore the evidence.

The burden of proof was on petitioner to show that the term "NuGrape" had acquired a secondary meaning.⁵ That burden is not a light one or easily sustained.⁶ In determining whether a term has acquired a secondary meaning "evidence coming from the consuming public as to its reaction to" the term is important.⁷ In order to establish a secondary meaning for the term in controversy the burden was on petitioner to show that the primary significance of the term in the minds of the consuming public

⁵ *Kellogg Co. v. National Biscuit Company*, 305 U. S. 111, 118; *Kellogg Toasted Corn Flake Co. v. Quaker Oats Co.* (6 Cir.), 235 Fed. 657; *Steem-Electric Co. v. Herzfeld-Phillipson Co.* (7 Cir.), 118 Fed. (2d) 122; *Sterling Products Corp. v. Sterling Producers* (D. C.), 45 Fed. Supp. 960; *Gillette Safety Razor Co. v. Triangle Mechanical Lab. Corp.* (D. C.) 4 Fed. Supp. 319; *Skinner Mfg. Co. v. General Food Sales Co.* (D. C.), 52 Fed. Supp. 432.

⁶ *Skinner Mfg. Co. v. General Food Sales Company*, 52 Fed. Supp. 432, Affirmed 8 Cir., 143 Fed. (2d), 895, Cert. Denied 323 U. S. 766.

⁷ *Steem-Electric Corp. v. Herzfeld-Phillipson et al.* (7 Cir.), 118 Fed. (2d) 122; *Charles Broadway Rouss, Inc. v. Winchester Co.* (2 Cir.), 300 Fed. 706, 717; *Zangerle & Peterson Co. v. Venice Furniture Novelty Manufacturing Company* (7 Cir.), 133 Fed. (2d) 266, 270; *Bayer Company, Inc. v. United Drug Company* (D. C., S. D., N. Y.), 272 Fed. 505.

is not the product but the producer.⁸ This it has not done. Long use, extensive advertising, large volume of sales, neither singularly nor collectively suffice to establish a secondary meaning for the term "NuGrape."⁹

None of the witnesses called on behalf of petitioner represented the consuming public. Eight of the witnesses called on behalf of respondent represented the consuming public. The testimony of these consumer witnesses bearing on the significance of the term "NuGrape" is set forth under Point A. This testimony shows that the term signifies to the ordinary consumer the type of product rather than the producer. The District Court so held (Con. of Law VII, R. 19, 20) and the Circuit Court of Appeals approved (164 Fed. [2d] 874, 877).

With respondent's evidence showing that the term "NuGrape" signifies to the ordinary consumer the type of product rather than the producer and petitioner having failed to show that the primary significance of the term in the minds of the consuming public is not the product but the producer, petitioner's assertion that the Circuit Court of Appeals in failing to hold the term had acquired a secondary meaning ignored the evidence is without foundation.

Under Points A and B we have shown that the Circuit Court of Appeals did not ignore the evidence, the Federal

⁸ *Kellogg Co. v. National Biscuit Company*, 305 U. S. 111, 118.

⁹ *Kellogg Co. v. National Biscuit Company*, 305 U. S. 111; *Selchow & Righter Co. v. Western Printing & Lithographing Co. et al.* (D. C., Wis.), 47 Fed. Supp. 322; *Skinner Mfg. Co. v. General Food Sales Company*, 52 Fed. Supp. 432; affirmed 8 Cir., 143 Fed. (2d) 895, Cert. Denied 323 U. S. 766.

Trade-mark Act of 1905 or the controlling authorities in holding the term in controversy to be invalid as a statutory or technical trade-mark.

Point D.

The Holding of the Circuit Court of Appeals that petitioner's evidence fails to show an infringement on the part of respondent by unfair trade practices is not in conflict with a late Decision of the Supreme Court and Decisions of other Circuit Courts.

The term in controversy is invalid as a statutory or technical trade-mark because of descriptiveness. Petitioner failed to establish a secondary meaning for the term and from its meager evidence neither of the lower courts found that the term had acquired a secondary meaning. The term denotes "the type of product rather than the producer" (Con. of Law VII, R. 20; 164 Fed. [2d] 874, 877).

The evidence shows that respondent selected and uses the term "TruGrape" to describe his own product and that the term is descriptive of the product. Respondent testified "when I arrived at the formula * * * we decided it was a very true character of grape and that gave * * * the suggestion. That is why we selected 'TruGrape' because it described what we had (R. 52, 53) * * * it serves to denote that product in that it describes the beverage very well" (R. 48).

Respondent's use of the term "TruGrape" to truthfully describe his own product does not constitute a legal or

moral wrong.¹⁰ The only obligation resting upon him is to identify his own product so as not to be mistaken for that of petitioner.¹¹ This obligation respondent fully discharges. His bottles are much smaller than petitioner's, there is a marked difference in the shape and appearance of the bottles, the bottle crowns are not the same color, the labels and markings on the bottles are different in color, shape and appearance and the color and flavor of the beverages are different. Respondent's business name and address "The TruGrape Company, Duncan, Oklahoma," plainly appear on each of his bottles (R. 50).

The evidence fails to show any conduct on the part of respondent tending to pass or "palm" off his product as that of petitioner. It also fails to show any conduct, acts or practices on the part of respondent, his agents, servants, and employees employed for the purpose of pirating the trade or business of petitioner (Finds. of Fact XVIII, R. 17). The evidence also "completely fails to meet the test that the ordinary prospective purchaser exercising due care under the circumstances would be misled." (164 Fed. [2d] 874, 877).

In the *NuEnamel* case (305 U. S. 315) the Supreme Court had under consideration the mark "NuEnamel"

¹⁰ "A name which is merely descriptive of the ingredients, qualities or characteristics of an article of trade cannot be appropriated as a trade-mark and the exclusive use of it afforded legal protection. The use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product." *Warner & Co. v. Lilly & Co.*, 265 U. S. 526, 528; see also *Standard Paint Company v. Trinidad Asphalt Co.*, 220 U. S. 446, 453; *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U. S. 118, 140.

¹¹ *Kellogg v. National Biscuit Company*, 305 U. S. 111, 119.

which the defendant in that case admitted in its answer had acquired a secondary meaning. The Court at pages 335 and 336 in speaking of the effect of such a mark said:

"Here we have a secondary meaning to the descriptive term, 'NuEnamel'. This establishes, entirely apart from any trade-mark act, the common law right of the NuEnamel Corporation to be free from the competitive use of these words as a trade-mark or trade name. * * * this right of freedom does not confer a monopoly on the use of the words. It is a mere protection against their unfair use as a trade-mark or trade name by a competitor seeking to palm off his products as those of the original user of the trade name. This right to protection from such use belongs to the user of a mark which has acquired a secondary meaning."

The mark involved in the instant case is merely descriptive of the product. It is not a valid trade-mark under the trade-mark act and has not acquired a secondary meaning and hence it is not entitled to the protection accorded the term "NuEnamel" in the *NuEnamel* case. The decision of the Circuit Court follows the decisions of the Supreme Court in *Standard Paint Company v. Trinidad Asphalt Mfg. Co.*, 220 U. S. 446; *Warner & Co. v. Lilly & Co.*, 265 U. S. 526; *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U. S. 118, and *Kellogg v. National Biscuit Co.*, 305 U. S. 111, and conflicts in no respect with the decision in the *NuEnamel* case.

N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 102 Fed. 327, was a suit to restrain infringement of a trade-mark. *Fuller v. Huff et al.*, 104 Fed. 141, was a suit for un-

fair competition, the mark involved had acquired a secondary meaning. The rules applied in these cases are the rules applicable to cases involving a valid trade-mark or a mark which has acquired a secondary meaning, they are not applicable to the mark in the instant case which is not a valid trade-mark and has not acquired a secondary meaning. The decision of the Circuit Court of Appeals in no way conflicts with these decisions.

CONCLUSION

It is respectfully submitted that this case is not a proper one for review by *certiorari* in this Court, and that the petition for a writ of *certiorari* should be denied.

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